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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,759	01/23/2002	John Sidney Stewart	PU 020022	7319
<div>7590 01/02/2008</div> <div>JOSEPH S. TRIPOLI THOMSON MULTIMEDIA LICENSING INC. 2 INDEPENDENCE WAY P.O. BOX 5312 PRINCETON, NJ 08543-5312</div>				
			EXAMINER SHANG, ANNAN Q	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 01/02/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/055,759

Applicant(s)

STEWART, JOHN SIDNEY

Examiner

Annan Q. Shang

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/18/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular independent claims 1 and 11, line 3+ recites "...a beginning segment of a multimedia presentation which is broadcasted over at least two channels..." It is unclear as to the broadcasting of "a beginning segment...over at least two channels..."

Response to Arguments

3. Applicant's arguments filed 09/20/07 have been fully considered but they are not persuasive.

With respect to the rejection of claims 1-20, in the last office action, applicant's discusses the prior arts of records and further argues that the prior art of record do not teach the claim limitations (see page 2+ of Applicant's Remarks).

In response, Examiner disagrees. Examiner notes applicant's arguments, however, do to the above 112 rejection, William reference meets the claim limitation.

William discloses recording scrambled program including a plurality of segments, which are broadcast over at least two channels where the program includes a menu to enable a user to select to view a desired program. Once a user selects a program to view from the menu, the Receiver receives a key or code for descrambling the beginning segment to enable viewing of the rest of the program. Note that once the beginning segments is descramble the processor (70) of the receiver, which interfaces between selecting circuit 54, switch matrix 52, hard drive 48, etc., initiate recording of a segment, playing of a previously recorded segment or directly displaying a live broadcast segment, which meets all the claim limitations. Applicant's arguments are not persuasive, the rejection of the last office action is proper, meets all the claim limitations as repeated below. **This office action is made Final.**

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 8, 10-18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Willard (6,622,305)**.

As to claim 1, note the **Willard** reference figures 1-4, discloses system and method for displaying near video on demand (NVOD) and further discloses a method for providing multimedia presentations on demand in a near on demand environment, comprising:

A multimedia recorder (fig.1, STB-38) configured for pre-recording a beginning segment of multimedia presentations which are broadcasted over at least two channels with a periodic interval being a difference of time between the start of the broadcast of the multimedia presentation over a first channel and a second different channel, the beginning segment having a time duration at least as long as the periodic interval (figs.1-4, col.1, line 66-col.2, line 25 and col.3, line 5-col.4, line 29); and

A multimedia system controller (Processor/Switch Matrix 'PSM' 70/52) operatively communicating with the multimedia recorder and responsive to a user request for performance of a selected one of the multimedia presentation causing the IRD to:

Commencing playback of the beginning segment corresponding to the multimedia presentation, where the beginning segment is received unscrambled; commencing recording of the multimedia presentation for which a broadcast has already begun, where the rest of the multimedia presentation, which is not the beginning segment of the multimedia presentation, is received scrambled (col.3, line 66-col.4, line 48, line 51-col.6, line 13 and line 58-col.7, line 1+); and

Switching from the playback of the beginning segment to playback of the recording of the rest of the multimedia presentations when program content of the

beginning segment corresponds with program content of the rest of the multimedia presentation contained in the recording (col.3, line 66-col.4, line 48, line 51-col.6, line 13 and line 58-col.7, line 1+).

As to claim 2, Willard further discloses where the method comprises pausing the multimedia (MM) presentation by stopping the playback of at least one of the beginning segment and recording of the selected one of the MM presentations while continuing to record the selected one of the MM presentations (col.12, line 55-col.13, line 9).

As to claim 3, Willard further discloses at least one of rewinding and fast forwarding the playback of the recording of the rest of the MM presentations while continuing to record the rest of the MM presentations (col.3, line 66-col.4, line 29, line 58-col.5, line 67)

As to claim 4, Willard further discloses where the beginning segment and the selected one of the MM presentations are recorded on a common storage medium (col.3, line 66-col.4, line 29).

As to claim 5, Willard further discloses where the common storage medium is selected from a group consisting of a magnetic disk medium, an optical disk medium and an electronic storage medium (col.3, line 66-col.4, line 29).

As to claim 6, Willard further discloses where the method comprises alternately reading from the common storage medium for the playback of the pre-recorded beginning segment and recording of the selected one of the MM presentations on the common storage medium (col.3, line 66-col.4, line 29, line 58-col.5, line 67).

As to claim 8, Willard further discloses automatically pre-recording beginning segments upon initial activation of a MM system (col.3, line 66-col.4, line 29, line 58-col.5, line 67)

As to claim 10, Willard further discloses where the MM presentations are presented on one of the group consisting of a TV display, video display, a computer display, etc., (col.3, line 36-col.4, line 29).

As to claim 11, the claimed "A system for providing multimedia presentations on demand in a near on demand environment..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

As to claim 12, Willard further discloses a system comprising a user interface that receives user commands and communicates the user commands to the MM system controller (col.3, line 36-col.4, line 29 and line 58-col.5, line 17).

As to claim 13, Willard further discloses where the user interface comprises a menu of the MM presentations available to a user from which the user can select a MM presentation for performance (col.3, line 36-col.4, line 29 and line 58-col.5, line 17).

As to claim 14, Willard further discloses a system comprising a control responsive to a user input that when activated pauses the MM presentation by stopping the playback of at least one of the beginning segment and the recorded portion while continuing to record the selected one of the MM presentations (col.3, line 66-col.4, line 29, line 58-col.5, line 67).

Claim 15 is met as previously discussed with respect to claim 3

Claim 16 is met as previously discussed with respect to claim 4.

Claim 17 is met as previously discussed with respect to claim 5.

Claim 18 is met as previously discussed with respect to claim 8.

Claim 20 is met as previously discussed with respect to claim 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Willard (6,622,305)** as applied to claim 4 above, and in view of **Yoshizawa et al (6,002,694)**.

Willard is silent to inhibiting playback of the recording of the rest of the multimedia presentation after a presentation of the selected multimedia presentation is completed.

However, **Yoshizawa** discloses preventing playback of said recording of said selected one of the plurality of multimedia presentations upon completion of said presentation (upon completion reads on "end" of viewing/re\viewing within a specific time; outside of the specific time, the viewer is not able to view of re-view unless the viewer pay for the request; Col. 5, lines 46-53); Yoshizawa discloses the use of a descrambling code key for descrambling the requested scrambling media (Col. 8, lines 41-63).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Willard with the teaching of Yoshizawa for providing an interactive, chargeable billing system while preventing infringement of copyright of video content, as suggested by Yoshizawa.

8. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Willard (6,622,305)** as applied to claims 1 and 11 above, and in view of **Sciammarella (6,281,940)**.

As to claims 9 and 19, Willard fails to explicitly teach periodically updating beginning segments with new beginning segments corresponding to subsequent MM presentations.

However, note the **Sciammarella** reference figures 1 and 6-8, discloses display of previewed channels with rotation of multiple previewed channels and periodically updates the beginning segments or preview with new segments (fig.6, col.3, lines 13-27, col.4, lines 8-34, col.6, lines 30-45 and col.7, line 51-col.8, line 12).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Sciammarella into the system of Willard in order to continuously provide the receiving system or the user with changes or new previews as events unfolds.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at 866-217-9197 (toll-free). If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Annan Q. Shang', enclosed within a rectangular box. The signature is stylized with loops and a large 'X' at the beginning.

Annan Q. Shang